

REMARKS

Reconsideration of the rejections set forth in the Office action mailed August 26, 2003 is respectfully requested.

I. Amendments

Claim 1 has been amended to incorporate the subject matter of original claim 18, which was found allowable in the Office Action.

Claims 2-3 are amended for clarity, as discussed further below.

No new matter is added by any of the amendments.

II. Rejections under 35 U.S.C. §112, Second Paragraph

Claim 2 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In order to clarify the subject matter of the claim, the structural representation of a morpholino subunit has been moved from the end of the claim to a position immediately below the reference in the claim to morpholino subunits. The phrase "as shown below" has been amended to "as shown in the structure below" for additional clarification. The reference to "the structure below" should be unambiguous, since only one "structure" is included in any of the claims.

In view of the foregoing, the applicants submit the amended claims comply with the requirements of 35 U.S.C. §112, second paragraph.

III. Rejections under 35 U.S.C. §112, First Paragraph

Claims 1-7 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention.

To expedite allowance, independent claim 1 has been amended to incorporate the subject matter of original claim 18, which was found allowable in the Office Action. Since the claim

now recites a specific SEQ ID NO: disclosed in the specification, the written description requirement is clearly met. Accordingly, the applicants request that the rejection be withdrawn.

IV. Additional Remarks

Although, in view of the amendments, the term "normal splice acceptor site" is no longer used in the pending claims, the applicants nonetheless wish to comment on the Examiner's interpretation of this term. The applicants cannot agree with the Examiner's conclusion (pages 5-6 of Office Action) that "the term 'normal splice acceptor site' would also encompass normal cryptic sites [sic] within the...gene". In the specification, "normal" and "cryptic" splice sites are clearly described as different entities; for example:

A cryptic or latent splice acceptor, 44 bp distal to the normal splice acceptor position, was used... (page 13, line 11)

...the sequence between the normal splice acceptor site and the alternate (or "cryptic") splice acceptor site... (page 15, line 30)

If the cryptic site is out of frame with the normal site... (page 16, line 8)

The next probable cryptic splice site is at base 100.... This site is out of frame with the normal site... (page 18, line 31)

A possible cryptic splice site is at base 145.... This site is in frame with the normal splice site... (page 19, line 11)

It would be clear to one skilled in the art that a "normal" splice site is a site used in normal splicing of a pre-mRNA. It would also be clear upon reading the specification that a "cryptic" site is one used when the normal site is unavailable, resulting in abnormal splicing. The term "normal cryptic site" (used in the Office Action) is used nowhere in the specification and, in view of the specification, is self-contradictory.

V. Conclusion

In view of the foregoing, the applicants submit that the claims now pending are now in condition for allowance. A Notice of Allowance is, therefore, respectfully requested.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4403.

Respectfully submitted,



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